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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,880	12/30/2003	Michael J. Robrecht	59412US002	8440
32692 7590 05/04/2007 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER OSORIO, RICARDO	
			ART UNIT 2629	PAPER NUMBER
			NOTIFICATION DATE 05/04/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/748,880

**Applicant(s)**

ROBRECHT ET AL

**Examiner**

RICARDO L. OSORIO

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 2-19,21-28 and 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,20,29 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/19/04 &amp; 4/1/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of species 3, Figs. 4(a) and 4(b), which includes claims 1, 20, 29, and 34, claims 1, 29 and 34 being generic in the reply filed on 2/9/2007 is acknowledged. Claims 2-19, 21-28, and 30-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/9/2007. Claims 1, 20, 29, and 34 will be examined below.

Applicant's election with traverse of species 3 in the reply filed on 2/9/2007 is acknowledged. The traversal is on the ground(s) that a search of the classes appropriate to the elected species would include the classes in which the non-elected species would be searched. This is not found persuasive because this case includes a number of patentable distinct species, which if examined or searched together, would certainly impose a serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1, 29, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Baur (6,172,668).

Regarding claim 1, Baur discloses a stylus (Fig. 1, ch. 1) for use with a user input device comprising a housing (Fig. 2, ch. 9) comprising an entrance aperture configured to collect ambient light (col. 2, lines 53-59, and 63-67) and an exit aperture (Fig. 2, ch. 12) configured to emit the collected light, wherein the exit aperture is proximate a tip of the stylus (col. 2, lines 59-62. The exit aperture is at the tip); and a light guide disposed within the housing (Fig. 7B, ch. 76), wherein the light guide is in optical communication with the entrance aperture and the exit aperture such that the light guide directs collected light from the entrance aperture to the exit aperture (col. 3, lines 51-61); wherein the stylus produces a defined intensity profile detectable by the user input device when at least a portion of the tip of the stylus is proximate an input surface of the user input device (col. 2, lines 43-51).

As to claims 29 and 34 (method version of claim 29), Bauer, further, discloses an electronic display system (Fig. 1, ch. 2), comprising a user input device (col. 1, lines 9-11), wherein the user input device comprises a plurality of light sensors disposed to detect light transmitted through an input surface of the user input device (col. 1, lines 9-11. Although not specifically mentioned, it is inherent for a photosensitive digitizer, or a photosensitive sheet material to have light sensors); a stylus (Fig. 1, ch. 1) configured to collect ambient light and emit the collected light through a tip of the stylus (col. 2, lines 59-62), wherein the stylus produces a defined intensity profile detectable by the plurality of light sensors of the user input device when at least a portion of the tip of the stylus is proximate the input surface of the user input device (col. 2, lines 59-62); and electronics coupled to the plurality of light sensors and configured to determine the location of the defined intensity profile produced by the stylus at a reference plane (col. 1, lines 9-11, and col. 2, lines 46-51. Although not specifically mentioned, it is inherent that the light sensors will determine by electronic means the location of the detectable light intensity); and an electronic display disposed to display information through the input surface of the user input device (col. 2, lines 46-51).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baur in view of Oikawa et al. (4,320,292).

As to claim 20, Bauer does not specifically teach of the stylus further comprising a resilient member coupled to a cylinder positioned within the housing proximate the tip, wherein the cylinder forms the exit aperture, wherein the cylinder is slidably coupled to the tip such that the cylinder changes the cross-sectional area of the emitted light when at least a portion of the tip is in contact with the input surface of the user input device.

Oikawa discloses a light stylus having a resilient member coupled to a cylinder, or to a cone, positioned within the housing proximate the tip, wherein the cylinder, or cone, forms the exit aperture, wherein the cylinder is slidably coupled to the tip such that the cylinder changes the cross-sectional area of the emitted light when at least a portion of the tip is in contact with the input surface of the user input device (col. 6, lines 45-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the area of the emitted light, as taught by Oikawa, in the device of Bauer so that a light beam used for inputting a coordinate selection is detected only when desired by user to avoid unintended inputs.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is 571-272-7676. The examiner can normally be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala whose telephone number is 571-272-7681.

Any response to this action should be mailed to:

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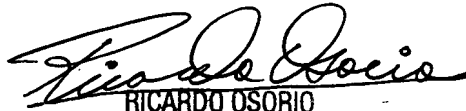
or faxed to: 571-273-8300 (for Technology Center 2600 only)

Hand-delivered responses should be brought to the Customer Service Window at the Randolph Building, 401, Dulany Street, Alexandria, VA 22314.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RICARDO OSORIO  
PRIMARY EXAMINER  
Technology Division: 2629

RLO

April 29, 2007